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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/595,677
Filing Date: June 19, 2000
Appellant(s): LAOR, RAVIV

Richard A. Neifeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 13, 2006 appealing from the

Office action mailed June 16, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- The examiner's objection of all claims under 35 USC 132(a) as being based upon new matter in the Office Action dated June 16, 2006 is hereby withdrawn. The applicant admitted, on Page 16, Section III, REMARKS, line 8 of the amendment filed on March 22, 2006, that "Now new matter has been added". While no attempt to clarify that this was a typographical error was made by the applicant in an After Final Amendment, the Appeal Brief filed on November 13, 2006 clarified the issue by stating, on page 4, lines 21-24, that: "In response, the applicant's statement that 'Now new matter has been added' included a typographical error, of 'Now' instead of 'No'. The correct statement should have been 'No new matter has been added'. Additionally, the applicant's arguments, in the Appeal Brief dated November 13, 2006, regarding the incorporation by reference, has clarified that the applicant was incorporating the entire contents of U.S. Patent No. 6,041,309 and not just the part of the document dealing with the commercial server system using the promotion server system to process the redemption of promotion. Since the sentence containing the incorporation by reference could be semantically parsed to include either interpretation, a clarification of the applicant's intent was all that was required to overcome the examiner's objection.

- Whether the rejections of claims 1-3, 11, and 28-31 under 35 USC 102(b) as being anticipated by Gerace (U.S. Patent Number: 5,848,396, hereinafter "Gerace") should be reversed is the only issue currently requiring review.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,848,396	Gerace	12-1998
"Webster's II New Riverside University Dictionary"	Riverside Publishing Company	(1988) Pg. 942

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Examiner's Rejections of Claims 1-3, 11, and 28-31 under 35 USC 102(b) as being anticipated by Gerace (U.S. Patent Number: 5,848,396).

- Independent Claims 28 and 30

  Claims 28 and 30: Gerace discloses a system and computer network implemented method for managing promotions over a network comprising:

  a. A promotion server. (Col 3, lines 39-67 and Col 4, lines 30 - 47)

  b. A retailer's commercial server. (Col 3, lines 39-67 and Col 4, lines 11 – 36)

  c. A consumer's client computer. (Col 3, lines 39-67, Col 4, lines 1 - 10)

d. Wherein said advertiser's promotion server; said retailer's commercial

server; and said consumer's client computer are operably connected to

the Internet, and are structured and programmed so that said consumer's

client computer can request from said retailer's commercial server a

promotion; and said retailer's commercial server responds to request from

said consumer's client computer for said promotion by automatically

obtaining from said promotion server promotion authorization data for said

promotion, and said retailer's commercial server determines from said

authorization data whether to accept or decline said promotion. (Col 3,

lines 39-67; Col 5, lines 8 – 40; and Col 11, line 57 through Col 12, line

56) (The Gerace invention checks to see if a viewing opportunity is

adequate. If the viewing opportunity meets the advertisers display

requirement, the commercial server accepts (inserts) or declines the

advertisement to the consumer.)

• Claim 1

Claim 1: Gerace discloses a system and method for managing promotions

over a network, comprising:

a. A promotion server system including a computer processor and associated

datastore, said datastore containing data representative of terms and

statistics of one or more item promotions and electronic tokens, said

commercial server system being selectively coupleable to said promotion

server system over said network. (Col 3, lines 39-67 and Col 4, lines 30 -

47)

b. A commercial server system including a computer processor and

associated commercial datastore, said commercial datastore containing

data representative of terms and statistics of one or more item promotions

and electronic tokens, said commercial server system being selectively

coupleable to said promotions server system over said network. (Col 3,

lines 39-67 and Col 4, lines 11 – 36)

c. A client server system including a computer processor and associated

client datastore, said client datastore containing data representative of

terms and statistics of one or more item promotions and electronic tokens,

said client server system being selectively coupleable over said network to

said promotion server system and to said commercial server system. (Col

3, lines 39-67, Col 4, lines 1 - 10) (Since the promotion is displayed on a

clients computer, the clients computer inherently has a datastore

containing data representative of the terms and statistics of the displayed

coupon in a datastore (temp file or virtual memory))

d. Wherein said commercial server system further includes a script for

generating a website frame having a predetermined signature. (Col 4, line

56 through Col 5, line 25)

    e. Wherein said commercial server system distributes said website frame over said network to said promotion server system. (Col 3, lines 39-67; Col 5, lines 15 – 25)

    f. Wherein said client server system connects to said promotion server system over said network. (Col 3, lines 39-67)

    g. Wherein said promotion server system transmits said electronic token from said website frame over said network to said client server system. (Col 4, lines 50 – 55)

    h. Wherein said promotion server system transmits over said network to said commercial server system coupon information associated with the client received from said electronic token. (Col 5, lines 8 – 40)

- Dependent Claims

Claim 2: <u>Gerace</u> discloses a system for managing promotions over a network as in Claim 1 above, and further discloses the commercial server system accepting or declining the promotions (Col 17, line 53 – Col 20, line 30, especially Col 19, lines 33-41).

Claim 3: <u>Gerace</u> discloses a system for managing promotions over a network as in Claim 1 above, and further discloses the promotion server system providing statistics pertaining to the number and value of redeemed

promotions to the commercial server system (Col 11, line 57 – Col 13, line 33).

Claim 11: <u>Gerace</u> discloses the system of Claims 1, and further discloses using a screen display to display the promotion data when requested (opted) by the commercial server system (Col 11, line 57 – Col 13, line 33 and Col 17, line 53 – Col 20, line 30).

Claims 29 and 31: Gerace discloses the system of claims 28 and 30 respectively, wherein said retailer's commercial server selecting a promotion accounting report option, wherein said promotion server transfer transfers screen display data to said retailer's commercial server system that provides said retailer's commercial server system with statistics that include the dollar value of promotions redeemed by said consumer's client computer. (Col 5, lines 26 – 40)

(10) Response to Argument

• Regarding the applicants arguments in the Overview on page 6, lines 14-19, which are not directed towards any specific claim.

  • The applicant argues that Gerace is not directed to security of promotions. The examiner is unable to locate any limitation in the currently pending claims that mentions the "security of promotions".

- The applicant argues that Gerace does not disclose a three computer system including consumer's client computer that requests redemptions from a retailer's computer system wherein the retailer computer system responds to that request by requesting information from a back-end computer system relevant to whether to grant the consumer a promotion. However, Gerace discloses a system and a computer network that implements a method to provide targeted promotional material to end-users over a network. (Gerace, Abstract). The server (Fig. 1, 27) implements a cluster of computer servers to perform the inventive tasks disclosed in the Gerace patent. The use of multiple computer servers to accomplish these tasks is disclose in Col 3, lines 62-65 where Gerace states "In the preferred embodiment, the server (Fig. 1, 27) is described as being "a Digital Equipment Corp. Alpha Server cluster, or a multiplicity of similar such servers (Col. 3, lines 62-63). Gerace teaches that the server cluster operates to manage a "program that has in its most general form; an agate data assembly (71), a user profiling member (73), an advertisement module (75) and a program controller (79) as illustrated in Fig 2" (Col 4, lines 36-40). In order to fully comprehend the Gerace disclosure it is important to understand the term "cluster". In computer science, the term "cluster" is used to describe a group of computers, or servers, that interconnected in such a way as to allow a single program and its process to be divided among the servers in the group. The

separation of program processes among the servers can provide operational and computational efficiencies that cannot be achieved by an individual computer server.

- The examiner is unable to locate any limitation in the currently pending claims, which requires a client computer to requests a redemption from a retailer's computer as argued by the applicant. Dependent claims 3, 29, and 31 are directed towards statistical data that includes volume or value of redemptions that is provided from a promotional server system to the commercial server system. Gerace discloses the use of statistical data, including redemption information in Col 5, lines 26-39 and Col 12, line 57 through Col 13, line 8

- The applicant argues that Gerace does not disclose frames having unique identification. The examiner is unable to locate any limitation in the currently pending claims in which frames are required to have unique identifications. Independent Claim 1 is the only claim that mentions the term frame. The limitation in claim 1 states that the said commercial server system includes a script for generating a website frame having a predetermined signature. Gerace specifically discloses this limitation in Col 4, line 56 through Col 5, line 25, where it is disclosed that the website frame is generated based upon the predetermined preferences of each user and the unique users computer ID when the user logs in.

- The applicant argues that Gerace does not disclose transfer of account statistical information. The examiner assumes that applicant is addressing this argument to Claims 3, 29, and 31. However, Gerace specifically discloses transferring account statistical information in Col 12, line 57-63, where he states "Another part of the Sponsors Objects 33a-d is a computer subroutine 41(Fig. 3a) which provides performance reporting. This enables the sponsors of the advertisements to obtain reports on successful use of the advertisements." Gerace also specifically discloses in Col 5, lines 26-40 that the "advertisement module records (a) the number of times and/or number of users to whom the advertisement has been displayed, (b) the number of times/users who have requested more information (via a click of a mouse on a corresponding menu item), and when possible (c) the number of purchases obtained through program 31's display of the advertisement. As such, advertisement module 75 holds performance data for each advertisement, and hence enables program controller 79 to provide performance reports to sponsors who log on to program 31."

- The applicant, on page 7, line 16 through page 8, line 26, appears to contend that Gerace does not use cookies to authenticate the user to the website. While Gerace does teach the use of cookies in the authentication process in Col 13, lines 36-46 and Col 14, lines 5-24, the

examiner is unable to locate a limitation in the currently pending claims that requires authentication to be performed via cookies.

- Regarding the applicants argument directed towards Claims 28 and 30:

  - The applicant attempts to distinguish between the terms "promotions" and "advertising" on page 9, lines 17-20 of the Appeal Brief, where he contends that a promotion imposes a financial obligation and an advertisement does not impose such an obligation. However, the terms "promotions" and "advertising", as commonly used in the marketing arts, are not able to be distinguished in such a manner. Promotions may contains financial obligations but do not require such an obligation to be considered a "promotion". Alternatively, advertisements may contain financial obligations but do not require such an obligation to be considered an "advertisement". Finally, The Webster's II New Riverside University Dictionary, published in 1988 defines promotion as "Advertising, publicity, and public relations".

  - The applicant argues on page 9, lines 21-25 that Gerace does not disclose or suggest the commercial server receiving a request from the user computer wherein the commercial server uses authorization data from the promotion server to determine whether to display a promotion to the user. However, Gerace discloses on Page 12, lines 23-41 that the Ad Series Objects contain information regarding the types of consumer the

sponsor requires to reach. Gerace also disclose in Col 13, lines 36-47

that "cookies" are stored locally on a user's PC for identifying the user and

his preferences. Next, Gerace discloses in column 15, lines 1-10 that the

main routine than determines is which advertisements are appropriate for

the user. Finally, Gerace discloses in Col 15, lines 45-48 that the server

transmits the generated screen view with the appropriate ads to the user.

- The applicant argues on page 10, lines 9-10 that Gerace "never requests

  the specific advertisement be transmitted and displayed to the user".

  While the examiner believes that the mere fact the user is accessing the

  web page is a request from the user for the advertisements, and as such

  satisfies the limitations of the claims as currently written. However,

  Gerace does specifically disclose the request for an advertisement from

  the user. In Col 2, lines 35-42, and Col 5, lines 26-40 Gerace discloses

  that user selects advertisements to receive information.

- The applicant argues on page 10, line 17-19 that Gerace does not

  disclose actions triggered by request for promotions from users. However,

  in Col 15, lines 1-56, Gerace discloses that comparing the user profile and

  the sponsor instructions triggers the action of determining and displaying

  an advertisement.

- Regarding the applicants argument directed towards Claim 1:

- The applicant argues on page 12, lines 1-2, that Gerace does not define associating a file or a datum (a token) with a full description of an electronic coupon. However, there is no limitation in Claim 1 that requires the "token" to be associated with a full description of an electronic coupon. The limitation set forth in claim 1 requires that the associated data stores contain data that is representative of terms and statistics of a promotion and electronic token. Additionally Claim 1, requires that the commercial system be able to generate a website frame having a predetermined signature wherein the electronic token uniquely corresponds to the signature. The actual limitations disclosed in Claim 1 are taught by Gerace (See the sections of Gerace cited in the reasons for rejection of claim 1 or alternatively these limitation can be found in Fig 5c; Col 12, lines 7-55; and Col 14, line 66 through Col 15, line 56.). The promotion server (advertising module) is associated with data representative of terms and statistics of a promotion (the advertisement itself and the requirements regarding the type of user the advertisement is to be displayed) and electronic token (package ID). The client system has cookies containing a unique user ID and the commercial server contains a data store regarding each unique users preference. When a user logs into the website, the commercial server retrieves the users preferences and generates a unique signature that represents the unique characteristics of the user. This signature is then compared with the Ad series data and a

website is generated based upon the comparison. Finally, statistics are generated regarding the users interaction with the ad and stored for reporting purposes.

- The applicant argues that Gerace does not disclose generating web site frame that has a predetermined signature. The applicant is correct that <\frame> is a specific type of HTML tag that divides a webpage into two or more screen displays each of which usually, but not necessarily, contains different data. However, Gerace discloses dividing the webpage using frames in Col 6, lines 23-29. The User Interface Object provides a screen display for each category of interest to the user each category is personalized to the unique user and thus represents a signature for that user. This signature is then used to select the appropriate advertisements, which each contain a unique ID (electronic token) and display requirements.

- Regarding applicant's arguments directed towards dependent claims.
  - The applicant argues that Gerace does not disclose "said promotion server system further includes an authorization code for enabling said commercial server system to accept or decline one or more of said promotions. Gerace discloses the acceptance of advertisements from sponsors when they have approved the advertisement and agreed to a price for displaying the advertisement based upon various negotiated

factors (Col 19, lines 33-41). Gerace also discloses another form of

acceptance of the advertisement in which the advertisement is being

accepted for display to the user. Gerace discloses that the sponsors

provide display criteria (Col 12, lines 23-42). The sponsor's display

criteria are checked against both the cookies from a users PC that

disclose the user ID and the computers display capabilities, and the

unique user profile (Col 5, lines 8-40; Col 6, lines 13-21; Col 14, lines 5-

24; and Col 14, line 66 through Col 15, line 10). The system is given

authorization to display the promotion when the criteria, capabilities and

the profile are a match. The system is declined authorization to display

the promotion when a match does not occur. (Col 15, lines 45-55)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the
Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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